

REMARKS

Formal Matters

Claims 1-19, 29 and 34-36 are pending after entry of the amendments set forth herein.

Claims 5, 15 and 19 are withdrawn from current consideration.

Claims 1-4, 6-14, 16-18 and 29 were examined. Claims 1-4, 6-14, 16-18 and 29 were rejected.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

The Office Action

Claims Rejected Under 35 U.S.C. Section 103(a) (Ravkin et al. in view of Henrichs)

In the Official Action of December 15, 2008, claims 1-3, 7, 17-18, 29 and 34-35 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Ravkin et al., U.S. Patent No. 6,908,737 in view of Henrichs, U.S. Patent Publication No. 2003/0161245.

The Examiner concluded, in his remarks on page 12, that Ravkin et al. includes a layer having a defined reflectivity (a transducing layer) cooperating with a digital data layer to produce a detectable data signal. The Examiner drew this conclusion from the assertion that Ravkin et al. discloses encoded patterns that can be provided by a carrier comprising a sandwich of individually discernable layers, which may differ in color, refractive index, reflectivity, shade, or texture (column 20, lines 49-56).

Applicants respectfully traverse the Examiner's position. Applicants would emphasize that the presently claimed transducing layer is not individually discernable from the digital data layer. Rather it is provided to facilitate reading the binary data of the digital data layer. Ravkin et al., on the other hand, as already noted previously, provides multiple layers of the encoded signal, each of which is individually discernable, and none of which function as a transducing layer as claimed. For these very same reasons, Ravkin et al. does not provide a binary digital data layer, but teaches away from the same.

Applicants have further amended claim 1 above to recite that at least one of said microbead particles is shaped differently from another of said microbead particles enabling said at least one particle

to be visually distinguished from said another of said microbead particles for identification purposes. Support for this amendment can be found, for example, at paragraphs [0016] and [0057] of the published version of the present application (USPAP 2004/0175843]. It is respectfully submitted that Ravkin et al. does not teach or suggest forming particles of different shapes so as to make them readily distinguishable from one another.

As to the previous argument that Ravkin et al. does not teach both a particle made of polymeric material and a transducing layer, and that the Examiner is attempting to read both the main body of the particle and the transducing layer on only the polymeric material that Ravkin et al. uses to make the particle, the Examiner reasserted the position that the sandwich layers disclosed by Ravkin et al. disclose a transducing layer. Applicants respectfully traverse. The claimed transducing layer is provided to facilitate reading of the digital data layer. As such, it is not an individually discernable layer, and this differs from Ravkin et al., since the layers are individually discernable and used to convey data, i.e., that are not transducing layers.

As to Applicants' argument that Ravkin et al. teaches away from producing a microbead having a binary signal, the Examiner disagreed noting that the prior art reference must discourage one of ordinary skill in the art, upon reading the reference, from following the path set out in the reference or would be led in a direction divergent from the path that was taken by the appellant. Applicants respectfully submit that Ravkin et al. would lead one of ordinary skill in the art in a direction that is divergent from producing a binary data signal. As already noted, at column 10, lines 7-11, Ravkin et al. discloses that the coding material can be made in a wide array of colors, optical characteristics and combination of colors and optical characteristics, and that consequently, greater information content is achieved with fewer coding positions as compared to traditional binary bar code formats. Clearly Ravkin et al. teaches away from producing a binary data signal, as one of ordinary skill in the art would be aware of the need for the ability to provide a large number of distinct codes and, after reading Ravkin et al., would not be motivated to modify the beads of Ravkin et al. in the manner suggested by the Examiner, as this would reduce the amount of information per coding position.

Further in this regard, the Examiner indicated that "disclosed examples and preferred embodiments do not constitute a teaching away from a broader discourse or nonpreferred embodiments". However, Ravkin et al. neither broadly discloses encoding that includes a binary data signal nor discloses any nonpreferred embodiments that include a binary data signal.

Still further, the Examiner asserted that a known or obvious composition does (sic, is) not patentable simply because it has been described as somewhat inferior to some other product for the same

use. However, compositions are not at issue here and therefore it is respectfully submitted that the Examiner's comment does not apply.

Accordingly, in view of the above remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1-3, 7, 17-18, 29 and 34-35 under 35 U.S.C. Section 103(a) as being unpatentable over Ravkin et al., U.S. Patent No. 6,908,737 in view of Henrichs, U.S. Patent Publication No. 2003/0161245, as being clearly inappropriate.

Claims Rejected Under 35 U.S.C. Section 103(a) (Ravkin et al. in view of Henrichs and Kolesar, Jr.)

Claims 4 and 6 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Ravkin et al., U.S. Patent No. 6,908,737 in view of Henrichs, U.S. Patent Publication No. 2003/0161245, as applied to claim 1 above, and further in view of Kolesar, Jr. et al. (sic, Kolesar, Jr.), U.S. Patent No. 4,906,440.

The Examiner asserted that Ravkin et al. teaches a dielectric material (column 15, lines 33-38) on polymeric material. However, column 15, lines 33-38 refers to an embodiment in which a silicon nitride or metal identification film 205 is deposited onto the patterned polysilicon film 204 in order to provide visual contrast to make the identification marks. There is no transducing layer, nor is there any suggestion of producing a detectable binary data signal. Accordingly, it is respectfully submitted that Kolesar, Jr. fails to make up for the deficiencies of Ravkin et al. And Henrichs in meeting the recitations of claim 1.

Claim 6 depends from claim 4 and it is respectfully submitted that claim 6 is therefore allowable for at least the same reasons provided above with regard to claims 4 and 1.

In view of the above remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 4 and 6 under 35 U.S.C. Section 103(a) as being unpatentable over Ravkin et al., U.S. Patent No. 6,908,737 in view of Henrichs, U.S. Patent Publication No. 2003/0161245, as applied to claim 1 above, and further in view of Kolesar, Jr. et al. (sic, Kolesar, Jr.), U.S. Patent No. 4,906,440, as being inappropriate.

Claims Rejected Under 35 U.S.C. Section 103(a) (Ravkin et al. in view of Henrichs and Tompkin et al.)

Claims 8-14 and 16 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Ravkin et al., U.S. Patent No. 6,908,737 in view of Henrichs, U.S. Patent Publication No. 2003/0161245, as applied to claims 1 and 7 above, and further in view of Tompkin et al., U.S. Patent No. 5,754,520.

It is respectfully submitted that claims 8-14 and 16 depend ultimately from claim 1, and are allowable over this combination of references for at least the same reasons submitted for the allowability of claim 1 over Ravkin et al. and Henrichs above, since Tompkin et al. does nothing to cure the deficiencies of Ravkin et al. and Henrichs in meeting all of the recitations of claim 1.

Accordingly, in view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 8-14 and 16 under 35 U.S.C. Section 103(a) as being unpatentable over Ravkin et al., U.S. Patent No. 6,908,737 in view of Henrichs, U.S. Patent Publication No. 2003/0161245, as applied to claims 1 and 7 above, and further in view of Tompkin et al., U.S. Patent No. 5,754,520, as being inappropriate.

New Claim

New claim 36 has been submitted above to depend from claim 1. Support for claim 36 can be found, for example, at paragraphs [0016] and [0057] of the published version of the present application (USPAP 2004/0175843). The Examiner is respectfully requested to indicate the allowance of claim 36 in the next Official Action.

Conclusion

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at 408-736-3554.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10030589-1.

Respectfully submitted,

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By: /Alan W. Cannon/
Alan W. Cannon
Registration No. 34,977

Agilent Technologies, Inc.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599